



SITRICK & SITRICK
8340 N LINCOLN AVENUE SUITE 201
SKOKIE IL 60077

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OFFICE OF PETITIONS

In re Application of
Ofek et al.
Application No. 09/535,831
Filed: 03/28/2000
Attorney Docket No. SYN 1756

DECISION ON PETITION
UNDER 37 CFR 1.137(a)

This is a decision on the petition under 37 CFR 1.137(a), filed January 17, 2006, to revive the above-identified application.

The application became abandoned for failure to file a timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action, mailed December 3, 2003, which set a shortened statutory period for reply of three (3) months. Applicants obtained an extension of time for response within the third month pursuant to 37 CFR 1.136(a). Accordingly, the application became abandoned on June 4, 2004.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Renewed Petition under 37 CFR 1.137."

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(l);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant 37 CFR 1.137(d).

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable." 35 U.S.C. § 133. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

In the present petition, applicants asserted that the delay in prosecuting the present application was unavoidable and through no fault of applicants or their representatives. Applicants explained that the basis of the final rejection in the present application involved a question of inventorship between the present application and Patent No. 6,272,131. Applicants filed a petition under 37 CFR 1.324 in Patent No. 6,272,131 to add an inventor on June 3, 2004, which was granted by the decision dated December 30, 2005. Applicants contended that they contacted the USPTO repeatedly since the filing of the petition in order to correct the inventorship and promote the prosecution of the present application. Applicants stated that the issue of inventorship was resolved approximately 1.5 years after the petition under 37 CFR 1.324 was filed. Applicants indicated that they were unable to file a Request for Continued Examination (RCE) because the application would have been finally rejected again in view of the fact that the petition under 37 CFR 1.324 had not been processed and granted. Applicants stated that the Examiner did not suspend prosecution of the present application while they were waiting for the Office to grant the petition under 37 CFR 1.324 in Patent No. 6,272,131, which resulted in the unavoidable abandonment of the present application.

Initially, the Office notes that it is incumbent upon an applicant to take steps to ensure against abandonment of an application. An applicant may delay action until the end of the time period for reply. In doing so, however, the applicant must assume the risk attendant to such delay. See Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901). Although applicants may have been in contact with the USPTO via telephone, applicants did not submit any written reply or other paper in this application to advance its prosecution. It appears that applicants waited almost two years for a decision on the petition under 37 CFR 1.324 in Patent No. 6,272,131 and did not prosecute this application during that period of time. There were several steps that applicants could have and should have taken to keep this application pending while also awaiting the outcome of the correction of inventorship in the patent. Applicants could have submitted a RCE (and fee) in response to the final Office action, accompanied by a request a suspension of action under 37 CFR 1.103 (c) (and fee). Additionally, applicants could have filed a request for an extension of time under 37 CFR 1.136(b) (and fee) due to USPTO delay pending the outcome of the 324 Request. Furthermore, applicants could have filed a continuing application.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Accordingly, the record reveals that applicants did not take appropriate and diligent actions to ensure that a proper and timely response was submitted in the USPTO so as to prevent the application from becoming abandoned. Applicants have not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Therefore, the petition under 37 CFR 1.137(a) is **dismissed**.

Alternative Venue

Applicants may wish to file a petition under 37 CFR 1.137(b) to revive the application on the basis of unintentional delay instead of submitting a renewed petition under 37 CFR 1.137(a).

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office communication, unless previously filed.
- (2) The petition fee as set forth in 37 CFR 1.17(m) (**an additional \$750.00 for a small entity**); and
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions